



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Mailed: MAY 15 2002

In re application of
Randell L. Mills
Serial No. 09/009,294
Filed: January 20, 1998
For: HYDRIDE COMPOUNDS

Paper Number

DECISION ON
PETITION

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This is a decision on the REQUEST FOR RECONSIDERATION OF DECISION ON PETITION, filed November 19, 2001, requesting reconsideration of the of the DECISION ON PETITION of Paper #37. This REQUEST FOR RECONSIDERATION OF DECISION ON PETITION alleges that the DECISION ON PETITION of Paper #37 fails to respond to the specific grounds on which Applicant's Petition was based and merely maintains that the Final Rejection is based on the same statutory grounds and the same reasoning as the first Office action. The DECISION ON PETITION of Paper #37 outlined the following two reasons for denial:

(1) No new ground of rejection was applied by the examiner in the Final Office action. The 35 USC 101 and 35 USC 112, first paragraph rejections were the same as those in the previous Non-Final Office action (in fact the examiner refers back to the previous Office action for the reasoning in making the rejections). The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of utility and enablement as set forth in the previous office action).

(2) A clear issue was in fact developed between the examiner and applicant in the Final Office action. In the Non-Final action mailed September 1, 2000, the only grounds of rejection were the 35 USC 101 and 35 USC 112, first paragraph rejections mentioned above. The examiner set forth reasoning to support these rejections. Applicant then replied to the rejections and the positions of the examiner. The rejections were maintained in the Final Office action and the examiner answered the arguments filed by applicant relating to the issue of whether the claims were lacking in utility and enablement. The issues in the present application are clear - whether the claims lack utility and are enabled to one of ordinary skill in the art.

DECISION

Petitioner's request for reconsideration can not be granted for the following two reasons:

(1) As detailed in the PETITION DECISION of Paper #37, no new ground of rejection was applied by the examiner in the Final Office action. The 35 USC 101 and 35 USC 112, first paragraph rejections were simply repeated as set forth in the previous Non-Final Office action of September 1, 2000. Specifically, both rejections simply state that the rejections are being maintained for "the reasons of record" without any additional stated basis for the rejections.

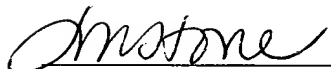
(2) While the statement in the Petition that the examiner incorporated additional reasoning in the Final rejection of the claims is correct, this was done solely to answer the substance of the applicant's traversal of the response dated March 1, 2001 to the Non-final Office action. As set forth in MPEP 707.07(f):

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

After an Office action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed. If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised.

Thus, the additional reasoning provided by the examiner in the Final Office action was in full compliance with the procedures detailed in MPEP 707.07(f).

Accordingly, this REQUEST FOR RECONSIDERATION is **DENIED**.



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Paper Number 43

In re application of
Randell L. Mills
Serial No. 09/009,294
Filed: January 20, 1998
For: HYDRIDE COMPOUNDS

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DECISION ON
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PETITION
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